

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: June 28, 2005

Opposition No. 91161603

Allergan, Inc.

v.

BioCentric Laboratories,
Inc.

Cindy B. Greenbaum, Attorney:

This case now comes up on opposer's motion to compel. The parties have fully briefed the issues.

As background, opposer served discovery requests on applicant on April 4, 2005, thereby making applicant's responses due by May 9, 2005. On June 8, 2005, after receiving no discovery responses from applicant, opposer contacted applicant by mail regarding the missing responses, and allowing applicant until June 13, 2005 to respond. On June 14, 2005, after receiving no response to the June 8, 2005 letter, opposer filed the instant motion.

In response, applicant states, among other things, that it never received opposer's discovery requests, and did not receive the June 8, 2005 letter until June 16, 2005.¹

¹ Applicant is advised that parties should not file with the Board discovery requests, discovery responses or materials or depositions obtained through the discovery process except when submitted with a discovery motion, in support of or in response

Trademark Rule 2.120(e) provides in pertinent part:

[A motion to compel] must be supported by a written statement from the moving party that such party or the attorney therefor has made a good-faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion and has been unable to reach agreement.

The Board finds that based on the record, opposer has not satisfied its obligation under Trademark Rule 2.120(e) to make a good faith effort to resolve the discovery disputes herein prior to seeking the Board's intervention. More specifically, a single letter to applicant, with no follow up by letter or telephone to determine whether applicant had received the first letter and/or discovery requests, does not rise to the level of even a *minimal* showing of a good faith effort to resolve the discovery disputes.

In view thereof, opposer's motion to compel is denied.

The parties are reminded that the purpose of discovery is to advance the case so that it may proceed in an orderly manner within reasonable time constraints. To this end, the parties must adhere to the strictures set forth in *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986), and repeated below:

[E]ach party and its attorney has a duty not only to make a good faith effort to satisfy the discovery needs of its opponent but also to make a good faith effort to

to a summary judgment motion, under a notice of reliance during a party's testimony period, or as exhibits to a testimony deposition. See authorities cited in TBMP §409.

seek only such discovery as is proper and relevant to the specific issues involved in the case. Moreover, where the parties disagree as to the propriety of certain requests for discovery, they are under an obligation to get together and attempt in good faith to resolve their differences and to present to the Board for resolution only those remaining requests for discovery, if any, upon which they have been unable, despite their best efforts, to reach an agreement. Inasmuch as the Board has neither the time nor the personnel to handle motions to compel involving substantial numbers of requests for discovery which require tedious examination, it is generally the policy of the Board to intervene in disputes concerning discovery, by determining motions to compel, only where it is clear that the parties have in fact followed the aforesaid process and have narrowed the amount of disputed requests for discovery, if any, down to a reasonable number.

The parties are directed to work together to resolve their discovery problems, in the spirit of good faith and cooperation that is required of all litigants in Board proceedings. In particular, no motion to compel should be filed unless the parties are truly unable, after making their best efforts, to work out mutually acceptable solutions to their discovery problems without the Board's help.

Dates remain as set.²

² Although the Board ordinarily suspends proceedings retroactively to the filing date of a motion to compel, inasmuch as the Board denied the motion for failure to establish the requisite threshold good cause, there is no reason to suspend proceedings. See Trademark Rule 2.120(e)(2), and *Opticians Ass'n of America v. Independent Opticians of America Inc.*, 734 F.Supp 1171, 14 USPQ2d 2021 (D.N.J. 1990), rev'd on other grounds, 920 F.2d 187, 17 USPQ2d 1117 (3d Cir. 1990).